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Application Number 10/748,364

Filing Date December 30, 2003

First Named Inventor Walker, Kenneth

Art Unit 2128


Examiner Name Jones, Hugh M.

Attorney Docket Number 03-010

ENCLOSURES (Check all that apply)

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Appl. No.: 10/748,364
Applicant: Kenneth A Walker, Jr. et al
Filed: December 30, 2003
Art Unit: 2128
Examiner: Hugh M Jones

Docket No.: 03-010
Customer No.: 37420

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This Appeal Brief is provided in reply to the Examiner's Answer mailed June 26, 2008.

I. Status of Claims

Pending claims 1-3, 5, 6, 8-21, 23, 24 and 26-36 have been twice rejected and are the subject of this appeal. Claims 4, 7, 22, 25 have been canceled. No other claims are pending.

II. Grounds of Rejection to be Reviewed on Appeal

Whether claims 1-3, 5, 6, 8-21, 23, 24 and 26-36 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Von Kaenel (U.S. Patent 7,107,285) in view of Applicants' comments regarding the prior art in the Background of the Invention section of the pending application (referred to by the Examiner as "Applicant's Own Admission", or "AOA").

III. Argument

Claims 1, 3-4, 6-8, 10, 16-18, and 20-21 are NOT unpatentable under 35 U.S.C. 103(a) as being unpatentable over Von Kaenel (U.S. Patent 7,107,286) in view of Applicants' comments regarding the prior art in the Background of the Invention section of the pending application (referred to by the Examiner as "Applicant's Own Admission", or "AOA").

Response to Examiner's Reply

Reply Section A. – page 9: no arguments.

Reply Section B. Response to Rejection of Claims Under 35 U.S.C.

§103 – page 9: The Examiner's statement that Appellant's cite case law is correct. This section points out that in order to overcome the 35 U.S.C. §103 rejection, the Applicant must show only that the Examiner has not made out a prima facie case of obviousness, or if it is determined that a prima facie case has been made, may submit rebuttal evidence of secondary indicia of nonobviousness. In the present application, the Applicant believes that they have shown that the Examiner has not properly built a prima facie case.

B1. Inventor's Own Work May not be considered prior art by admission

On page 14 of the Examiner's Reply, the Examiner states "It is noted that this is the first time this argument has ever been presented." However, the Appellant is unaware of any statutory or legal authority that dictates that new arguments cannot be presented for the first time in the Appeal Brief. Indeed, due to the intricacies of the statute, namely 35 U.S.C. § 134, arguments often appear for the first time on Appeal. In the present application, the claims were first rejected in the 1/17/07 Office Action. Appellant amended the claims in the Response of 7/12/07 into a form that they believed would overcome the stated rejections. The Final Office Action of 9/27/07 again rejected the claims. Under 35 U.S.C. § 134(a), the Appellant is now entitled to Appeal the rejections. This is

therefore the first opportunity in the prosecution history to date that the Appellant has had to make any of the arguments in response to the rejections with respect to the amendments made in the 7/12/07 response. The statute therefore necessitates at least some new arguments in the present application.

With regard to the Examiner's statement on page 15 that "Appellants did not properly challenge, in a timely manner, the finding that paragraphs 2-4 constitutes an admission", Appellant respectfully disagrees. In the First Office Action of 1/17/07, the Examiner's characterization of the Applicant's Own Admission ("AOA") is simply "printing by the vendor". See excerpt from First Office Action of 1/17/07:

4. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over von Kaenal in view of Applicant's Own Admission.
5. Von Kaenal et al. disclose incorporating maps into designs as discussed subsequently.
6. Von Kaenal et al. do not appear to disclose printing by the vendor.
7. AOA teaches the feature.
8. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Von Kaenal et al. with AOA because AOA discloses the advantages of using an external print service. See paragraphs 2-3 of the application (background of the art).

In response to the First Office Action the Appellant amended the claims to include:

"providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area”.

In the Final Office Action, the Examiner refers to paragraphs 2 through 4 of the Specification and alleges “Applicants have admitted in the specification that there s known problem, namely the need for custom printed materials”. The Appellant points out that this is the first opportunity that the Appellant has had to rebut this allegation.

Accordingly, the Appellant respectfully submits that the arguments presented in the Appeal Brief with regard to what does or does not constitute an admission have in fact been challenged in a timely manner.

B2. Prior Art Does Not Teach Claimed Invention

On page 23 of the Examiner’s Answer, the Examiner argues:

The Examiner did not ‘conclude’ as alleged above. The Examiner took notice that

A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in

printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

And thus concluded

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Von Kaenal et al. teaching to include editing/printing on both sides in the context of the Internet.

Appellants are still silent about whether:

A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

However, Appellant respectfully contends that the Examiner did not properly take “Official Notice”. First, the Examiner never stated that Official Notice was being taken. Rather, the rejection appears to be directed to Appellant’s alleged Admission rather than “Official Notice”. See, for example, the actual rejection, reprinted below from the Final Office Action of 9/27/07:

10. Von Kaenal et al. does not appear to disclose printing on two sides, as recited, for example, in amended claim 1:

providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user;
providing a tool allowing the user to supply at least text to be printed on the first side;
providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed;
providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area.

11. Applicants have admitted that it was known to edit various types of common print materials offline and that the editing tools were available.

[0002] Many individuals, businesses, and organizations occasionally have a need for custom printed materials, such as business cards, party invitations, product or service brochures, promotional postcards, or any number of other items. Some of these individuals and businesses turn to sources such as a local print shop for assistance in preparing the materials. Others may attempt to create the product themselves using specialized software purchased and installed on a personal computer to design the product and using their local printer attached to their personal computer to perform the printing.

12. A skilled artisan would recognize that the materials commonly include two sides, since there are usually two sides available for printing, and would recognize the advantages in printing on both sides including, for example, the ability to provide more information to a customer through one piece of printed material.

13. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Von Kaenal et al. teaching to include editing/printing on both sides in the context of the Internet.

It is understood by the Appellant that when an Examiner takes Official Notice in a rejection, the Examiner actually states that Official Notice is being taken. However, in the present application, the Examiner did not actually state that he was taking Official Notice.

Second, the actual rejection, as indicated above, is ambiguous because, at least to the Appellant, it is unclear as to whether the Examiner is referring to only printing on two sides (paragraphs 10 and 12 in the Final Office Action of 9/27/07) or printing on two sides in combination with editing “various types of common print materials offline” and the availability of “editing tools” (paragraphs 11 and

13 in the Final Office Action of 9/27/07). Since it is unclear as to what the “facts beyond the record” are actually alleged to be, the Appellant respectfully submits that the present invocation of the Official Notice doctrine is improper.

MPEP 2144.03 states “Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).” In the present application, however, it is unclear from the record as to what the facts beyond the record even are, and therefore such alleged “fact” cannot be said to be “capable of such instant and unquestionable demonstration as to defy dispute”.

On page 25 of the Examiner’s Answer, and in paragraph 16 of the Final Office Action of 9/27/08, the Examiner alleges the “Applicants have admitted that there is a known problem, namely the need for custom printed material.” The Appellant actually never admitted that “the need for custom printed material” is a “problem”, only that “individuals, businesses and organizations occasionally have a need for custom printed materials”. (Specification, paragraph 2). However, the Examiner’s characterization of the problem solved by the invention is overly broad. The problem solved by the invention is only that which is covered by the claims, including *each limitation*.

Claim recites:

“providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area”.

Yet, the Examiner never actually refers to where each of these claim limitations are found in the prior art. The Examiner’s statement that “Applicants have admitted that it was known to edit various types of common print materials offline and that the editing tools were available” and that “Applicants have admitted that there is a known problem, namely the need for custom printed material” are simply not relevant to the actual limitations of the claims.

The Examiner appears to combine an alleged Admission with, as has been elucidated in the Examiner’s Reply, an Official Notice and then makes a narrow application of *KSR, supra*, and yet never once ties it to the actual language of the claim limitations missing from von Kaenel.

The Appellant notes that the Examiner merely generalizes the actual language of the claims. See, for example, paragraphs 10 through 19 of the Final Office Action of 9/27/07. Appellant points out that the only reference to the actual claim language missing from the von Kaenel reference is in paragraph 10 of the Final Office Action where the Examiner admits that these claim limitations are not in the von Kaenel reference.

Unfortunately, the present application was written and filed prior to the guidance supplied to practitioners by the Supreme Court in *KSR Int’l Co. V. Teleflex Inc.*, 550 U.S. ___, 127 S. Ct. 1727 (2007). Prior to *KSR*, it was common practice by patent practitioners to describe common problems in the prior art in order to later elucidate the “advantages” of the proposed invention. Thus, the background section was commonly used as a lead-in to essentially “sell” the invention. Unfortunately, post-*KSR*, if Examiners are allowed to make an overly-broad statement of an alleged “problem” or “need” solved by an Applicant’s claimed invention, then very few, if any, applications would withstand the

application of *KSR*. It appears in the present application that this is exactly what happened. The Examiner cited a primary reference, von Kaenel, generalized the claim language missing from the von Kaenel reference, alleged that the generalized claim language was either admitted by the Appellant in the background section or allegedly was made up for by allegedly taking Official Notice, then constructed an overbroad statement of the problem, and applied *KSR* to reject the claims under 35 U.S.C. §103(a).

Finally, it must be pointed out that if the Appellant's recited limitations of the claims missing from von Kaenel were indeed so commonly available at the time of Appellant's invention, then presumably it would have required very little effort to cite an actual reference containing each of the essential limitations of the claims that are missing from von Kaenel.

B3. AOA Is Not Enabling

On page 28 of the Examiner's Answer, the Examiner states (in response to Appellant's statement on page 40 of the brief and reprinted in the Examiner's Reply on page 28), "This is mere allegation. Appellants have not provided a specific argument, evidence or expert testimony. This is not a credible statement. The Examiner notes that an atlas includes text and maps on both sides of the pages and such products are common."

The Appellant respectfully submits that, to the contrary, it is the Examiner who has not provided a specific argument, evidence or expert testimony that the alleged AOA teaches the actual language of the claim limitations missing from von Kaenel, including:

“providing an image of at least a portion of a first side of the product for displaying to the user of a client computer for customization by the user,

providing a tool allowing the user to supply at least text to be printed on the first side,

providing an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second

side of the product having a map area where a map will be printed when the product is printed,

providing a tool allowing the user to identify a location to be included within the map that will be printed in the map area”.

As explained above, the Examiner never actually refers to where each of these claim limitations is found in the alleged AOA. For example, where in the alleged AOA is it described that a product is displayed to a user including “an image of at least a portion of a second side of the product for displaying to the user for customization by the user, the second side of the product having a map area where a map will be printed when the product is printed”? The Examiner describes an atlas which includes text and maps on both sides of the pages. However, an atlas is a physical book, is not displayed on a computer, and does not allow editing.

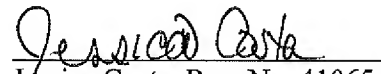
In summary, the Appellant asserts that it is the Examiner who has not met the burden of building a prima facie case. That is, the Applicant respectfully contends that the Office has not established a prima facie case of obviousness under 35 U.S.C. §103. In particular, the alleged AOA cannot be considered an admission of prior art and therefore cannot be used in formulating a rejection under 35 U.S.C. §103. In addition, even if it were to be considered prior art for the purposes of the present application, it is not enabling with respect to the limitations against which it is cited. Finally, even in combination, the Von Kaenel and AOA do not teach all of the limitations recited in Applicant’s claims.

Conclusion

For the reasons set forth above, Applicant respectfully submits that each claim is patentable and reversal of all rejections is respectfully requested.

Respectfully submitted,

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